



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ryoji WATANABE et al.

Group Art Unit: 3725

Application No.: 10/647,235

Examiner: J. PAHNG

Filed: August 26, 2003

Docket No.: 116939

For: SHREDDER APPARATUS AND SHREDDING METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is filed herewith. Applicants respectfully request review of the Rejection mailed March 22, 2007 in the above-identified application.

Claims 1, 2, 4-9, 11-13, 14 and 16-18 are pending in this application. No amendments are being filed with this request. An Amendment to cancel claim 19 was filed in the Patent Office on June 19, 2007. This review is requested for the following reasons.

I. Claim Rejection

The rejection of claims 1, 2, 5, 6 and 11 under 35 U.S.C. §103(a) over U.S. Patent No. 6,676,050 to Chang in view of U.S. Patent No. 6,758,392 to Bennett et al. (Bennett) and U.S. Patent No. 4,547,002 to Colgate, Jr. (Colgate) is in error.

II. The Examiner's alleged motivation for combining the references is improper

For combining Chang and Bennett, the Examiner states that it would have been obvious to one skilled in the art to provide Chang with a sensor and controller of Bennett "in order to control the destruction." (See p. 3 of the March 22, 2007 Office Action.) This is

merely an end result and is not a proper motivation for combination. The Examiner fails to provide sufficient support as to why one of ordinary skill in the art would have been motivated to add Bennett's sensor and controller for destroying a card into Chang's compact disc breaking device. Nonetheless, for the reasons discussed below, even if one of ordinary skill would have somehow been motivated to combine the references, the currently claimed invention still would not have been achieved.

III. The Examiner includes a clear factual error as to the teachings of the applied references

Claim 1 recites a transport path that transports an image display member including paper through a shredding apparatus, and a data destroy process unit that is provided along the transport path and destroys electronic data stored in the electronic data storage device as the paper passes thereby along the transport path.

The Examiner asserts in the Response to Arguments section of the Office Action that Applicant's arguments that Chang's paper shredder 1 cannot be provided along the compact disc inlet 12, as presented in the March 5, 2007 Amendment, is not germane to the patentability of claim 1 because Chang discloses rolling blade wheels 20, 30 provided along a transport path 12. Applicant respectfully disagrees and respectfully asserts that the Examiner misrepresents Chang's teaching.

As shown in Fig. 4 of Chang, an inlet 12 is provided specifically for breaking compact discs, and an inlet 11 is provided specifically for shredding paper 40. See col. 3, lines 3-8 and lines 13-20 of Chang. Therefore, if the paper is to be shredded, the user should insert the paper into the inlet 11. On the other hand, if a compact disc is to be broken, the user should insert the compact disc into the inlet 12. In other words, Chang specifically teaches that each inlet is used for specific purposes of shredding paper or breaking compact discs. Thus, the path from the inlet 12 that extends to the rolling blade wheels 20, 30 would not transport an image display medium including paper, as recited in claim 1.

The Examiner asserts at item 3 on page 3 of the Office Action that, although Chang does not explicitly disclose a display member comprising paper, Colgate is referenced to show that a credit card may be made of either plastic or paper. However, if a paper credit card, as taught by Colgate, is to be shredded using the shredding device of Chang, the paper credit card should be inserted into the inlet 11 as discussed above, because it is made of paper. Thus, the paper credit card will not be transported to the rolling blade wheels 20, 30 as taught by Chang. Thus, such an interpretation is not correct.

Furthermore, claim 1 recites a shredding process unit, which is also provided along the same transport path, that shreds the entered paper. The Office Action asserts that the rolling blade wheels 20, 30 of Chang shred the image display member. Applicant disagrees with this assertion.

Col. 3, lines 27-30 of Chang discloses "the data on the compact disc 50 may be broken simply by breaking the surface of the compact disc 50, without having to chop the compact disc 50" (emphasis added). Chang also discloses at col. 3, lines 65-col. 4, line 5 "the compact disc 50 may be inserted into the compact disc breaking zone 31 through the compact disc inlet 12 to be clamped between the second rolling blade wheel 20 and the third rolling blade wheel 30 that are rotated relative [to] each other, to break the surface of the compact disc 50 by scraping, denting, bending or deforming, thereby breaking and destroying the electronic storage medium data on the compact disc 50" (emphasis added). Therefore, the rolling blade wheels 20, 30 do not shred the image display member but break only the surface of the compact disc 50.

In fact, Chang teaches away from shredding the compact disc. As discussed at col. 1, lines 23-24, Chang teaches that the broken fragments of the compact disc easily hurt the user's body. In addition, Chang is directed to breaking the data of the compact disc as discussed at col. 1, lines 9-12, and teaches at col. 1, lines 35-42 that the user only needs to efficiently

break the protection layer and the plastic base plate so that the data on the reflective layer of the compact disc cannot be read out, thereby breaking the data of the compact disc.

Therefore, Chang teaches that the compact disc should not be physically shredded but only the surface of the compact disc needs be processed to break the data of the compact disc.

Furthermore, as shown in Fig. 2 of Chang, in contrast to the inter-engagement between the rolling blade wheels 20, 21, the blade wheels 20, 30 are provided with gaps. Therefore, even paper is inserted between the rolling blade wheels 20, 30 via the inlet 12, the paper will not be shredded but only be deformed by the rolling blade wheels. Therefore, the Examiner's assertion that the rolling blade wheels 20, 30 shreds the image display member is incorrect.

Regarding Bennett, the Examiner asserts that Bennett discloses a credit card destroy process unit with a sensor and controller capable of detecting an electronic data storage device in order to control the destruction. Applicant respectfully disagrees with this assertion.

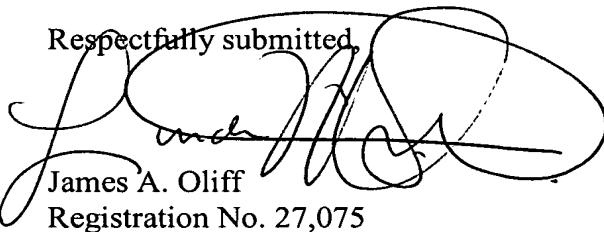
Bennett discloses at col. 1, lines 28-39 that his card destruction system comprises a reader for reading identification information from a card, that a controller is coupled to the reader to receive the identification information and to determine whether the card is to be destroyed, and that a delivery sensor is coupled to the controller to sense when the card is delivered to a card destruction device. Bennett also discloses at col. 4, lines 44-48 that as the card passes through reader 64, information is read from the card and passed to the controller 42 and that the controller 42 then accesses a database (which may be a remote computer) to determine whether or not the card has in fact been flagged for destruction. Therefore, Bennett's destruction of a card is based on the destruction status of that card, not whether the entered paper has an electronic data storage device attached to the entered paper, as recited in claim 1.

Accordingly, the Examiner has erroneously applied the references to reject the pending claims. Withdrawal of this rejection is respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should anything further would be desirable in order to place this application in even better condition for allowance, the Patent Office is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Linda M. Saltiel
Registration No. 51,122

JAO:LMS/tls

Attachment:
Notice of Appeal

Date: June 20, 2007

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400